

ADMINISTRATIVE PANEL DECISION

Secretlab SG Pte. Ltd. v. Julius Bergman
Case No. D2022-0662

1. The Parties

The Complainant is Secretlab SG Pte. Ltd., Singapore, represented by Welly Tantonno, Singapore.

The Respondent is Julius Bergman, France.

2. The Domain Name and Registrar

The disputed domain name <secretlabschair.com> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2022. On February 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on March 9, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 31, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on April 1, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a Singapore company that retails furniture, specifically video gaming chairs, under a trademark consisting of the word SECRETLAB (the "SECRETLAB Mark") and is the registrant of domain names containing the SECRETLAB Mark including the domain names <secretlab.eu>, <secretlab.co>, and <secretlabchairs.co.uk>.

The Complainant holds a number of registered trademarks for the SECRETLAB Mark, including United States of America trademark registration number 5,402,936, registered since February 13, 2018, for furniture in class 20.

The Domain Name <secretlabchair.com> was registered on December 17, 2021. It resolves to a website ("the Respondent's Website") that purports to offer products, including gaming chairs, under the Complainant's SECRETLAB Mark in direct competition with the Complainant's gaming chairs. It is not possible to buy the Complainant's SECRETLAB chairs through the Respondent's Website.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) the Domain Name is identical or confusingly similar to the Complainant's SECRETLAB Mark;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the SECRETLAB Mark having registered the SECRETLAB Mark in the United States of America and various other jurisdictions. The Domain Name wholly incorporates the SECRETLAB Mark along with the letter "s", the descriptive word "chair", and the generic Top-Level Domain ("gTLD") ".com".

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the SECRETLAB Mark. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Rather the Domain Name resolves to a page that offers gaming chairs in direct competition with the Complainant. This does not provide the Respondent with rights or legitimate interests.

The Domain Name was registered and is being used in bad faith. By using the Domain Name to resolve to a website that purports to offer gaming chairs in competition with the Complainant, the Respondent is using the Domain Name to disrupt the Complainant's business and divert Internet users searching for the Complainant to a competing website for commercial gain.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trademark or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trademark or service mark.

The Complainant is the owner of the SECRETLAB Mark, having registrations for the SECRETLAB Mark as a trademark in, amongst other places, United States of America, the United Kingdom, Singapore, and the European Union. The Domain Name wholly incorporates the SECRETLAB Mark along with the letter "s", the word "chair", and the gTLD ".com", which can be discounted as an essential element of any domain name.

Previous UDRP panels have repeatedly held that the addition of other terms to a wholly incorporated trademark (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"). See also *The Bank of Nova Scotia v. Whois Protection*, WIPO Case No. D2007-0884; and *Valero Energy Corporation, Valero Marketing and Supply Company v. Domain Name Proxy, LLC, Navigation Catalyst Systems, Inc.*, WIPO Case No. D2011-1227.

The Panel finds that the Domain Name is confusingly similar to the Complainant's SECRETLAB Mark.

Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights to or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the SECRETLAB Mark or a mark similar to the SECRETLAB Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods and services. The Respondent's use of

the Domain Name to display a webpage offering gaming chairs in direct competition with the gaming chairs offered by the Complainant does not, on the face of it, amount to use for a *bona fide* offering of goods and services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a Response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. (Policy, paragraph 4(b)).

The Panel finds that the Respondent must have been aware of the Complainant and its reputation in the SECRETLAB Mark at the time the Respondent registered the Domain Name. The Respondent has provided no explanation, and neither it is immediately obvious, why an entity would register a domain name incorporating the SECRETLAB Mark (with the addition of the term "chair" which is descriptive of the Complainant's products) and redirect it to a website purportedly offering gaming chairs unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its SECRETLAB Mark. In these circumstances, the Respondent's conduct in registering the Domain Name when it was aware of the Complainant's rights and lacked rights or legitimate interests of its own, amounts to registration in bad faith.

The Respondent's Website purports to offer gaming chairs in direct competition with the Complainant. Given that the Respondent has offered no plausible explanation for the registration of the Domain Name, the Panel finds that that the Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the SECRETLAB Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. As such, the Panel finds that the Domain Name is being used in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <secretlabschair.com>, be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: April 8, 2022